Appl. No.:   10/014,943
Amdt. dated September 18, 2003
Reply to Office action of June 19, 2003

REMARKS/ARGUMENTS

Applicant received the Office Action dated June 19, 2003, in which the Examiner rejected claim 5 under 35 U.S.C. § 112, second paragraph and rejected claims 1-27 as anticipated by Cromer (U.S. Pat. No. 6,256,732). In this response, Applicant amends claims 1, 5, 9-11, 16, 17, 24 and 25 and canceled claims 6-7, 12-13 and 26-27. Based on the amendments and arguments contained herein, Applicant believes the claims to be in condition for allowance. Accordingly, Applicant respectfully requests reconsideration and allowance of the pending claims.

The Examiner rejected claim 5 as lacking antecedent basis for the term "management logic" which was included in other dependent claims as well. Applicant amended claims 5, 9, 10, and 11 to address the Examiner's § 112 concern by replacing "management logic" with "separate device." This amendment does not narrow the scope of the claims in any way.

Regarding the art rejection of claim 1, Cromer is directed to a computer system having automatic registration for in-box configuration. See Title of Cromer. That is, the computer system 12 in Cromer can be configured while still in the shipping box via a flap 28 formed in the box. The boxed computer system can be connected to an auxiliary power supply and to a main computer 102. See Figures 1 and 4 of Cromer. The Summary of Cromer explains that "[t]he present invention is directed to a computer system which can automatically provide its capabilities to a main computer without powering on to facilitate configuring the system in its shipping package." Col. 2, lines 32-35. The boxed computer includes a communication subsystem that "is supplied with auxiliary power and is operative to communicate with the computer system regardless of whether the computer system is in a normal operating state." Col. 2, lines 42-45. It should be noted the steps of FIG. 8 (which specify opening the carton, connecting power and network cables, and sending packets between boxed computer 12 and main computer 102) are carried out without system 12 being powered on. Col. 9, lines 65-67. Thus, Cromer proposes configuration of the computer, while still in the

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shipping box, without booting up the computer and thus without the operation of the computer's CPU.

Applicant's amended claim 1 specifies that the separate device requests the host's CPU to coordinate the transfer of at least a portion of the host-specific information. By contrast, because the CPU in Cromer's computer system 12 is not powered on, Cromer naturally does not and cannot use the computer system's CPU to coordinate the transfer of any data to main computer 102. At least for this reason, Cromer does not anticipate nor render obvious claim 1.

All claims that depend on or from claim 1 are patentable for at least the same reasons as claim 1. Further, claim 9 requires that the separate device uploads the host specific information during power on self test of the host. Clearly, because computer system 12 in Cromer is not powered on (col. 2, lines 32-35; col. 9, lines 65-67), whatever data transfer occurs between computer system 12 and main computer 112 cannot occur during a power on self test of computer system 12. For at least this additional reason, claim 9 is patentable over Cromer.

Amended independent claim 17 is directed to a logic unit that, among other features, is adapted to upload host computer information during power on self test of a host computer system. As explained above with regard to claim 9, Cromer does not permit the boxed computer to upload its data during a power on self test event. Thus, claim 17 is patentable over Cromer. Applicant also amended claim 17 to ensure proper antecedent basis of the term "logic" in the body of the claim. The term "logic" has been replaced by "logic unit" to match the preamble of the claim. This latter amendment does not narrow the scope of the claim in any way.

All claims that depend on or from claim 17 are patentable for at least the same reasons as claim 17. Further, claim 20 specifies that the logic unit is adapted to request a CPU in the host computer system to coordinate the transfer of host computer specific information. In Cromer, the boxed computer system's CPU cannot be involved in the data transfer process. For at least this additional reason, claim 20 is patentable over Cromer.

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Independent method claim 24 has been amended to require uploading the information to the logic unit "with the involvement of a CPU in the host computer." As explained above, this feature is not taught or suggested by Cromer and thus claim 24 and its dependent claim 25 are allowable. Applicant also amended claim 24 to remove all references to the labels "(a)" and "(b)" to ensure that the order of the acts listed in claim 24 are not interpreted as necessarily being in the order given. Corresponding amendments have been made to claim 25.

In the course of the foregoing discussions, Applicant may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the prior art which have yet to be raised, but which may be raised in the future.

If any fees or time extensions are inadvertently omitted or if any fees have been overpaid, please appropriately charge or credit those fees to Hewlett-Packard Company Deposit Account Number 08-2025 and enter any time extension(s) necessary to prevent this case from being abandoned.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

Jonathan M. Harris
PTO Reg. No. 44,144
CONLEY ROSE, P.C.
(713) 238-8000 (Phone)
(713) 238-8008 (Fax)
ATTORNEY FOR APPLICANT

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
Legal Dept., M/S 35
P.O. Box 272400
Fort Collins, CO 80527-2400

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